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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,628	02/12/2001	Ursula Murschall	00/057 MFE	9521

7590

01/02/2004

ProPat, L.L.C.  
2912 Crosby Road  
Charlotte, NC 28211

EXAMINER
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CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/781,628

Applicant(s)

MURSCALL ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/2003 has been entered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-20 of U.S. Patent No. 6,641,924 (formerly Application No. 09/421,068), in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301).

U.S. Patent No. 6,641,924 claims a white, biaxially oriented film comprising at least one layer comprising polyester and the specified cycloolefin, as well as other features such as the recited whiteness, opacity, and gloss values; and the presence of additional layers, etc. However, the reference does not explicitly disclose the recited UV stabilizer and flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in the above patent in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches as indicated in claims 1-2 to incorporate the additives into the polyester composition. It would have been obvious to incorporate other fillers or pigments into the film in order to optimize the optical characteristics of the film as indicated in claims 1, 10, 14-16 in order to obtain the visual properties and physical properties required by

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a given application. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide protection for the inner core layers. One of ordinary skill in the art would have used conventional functional intermediate layers such as an adhesive layer between two film layers in order to improve the interlayer adhesion as indicated in claim 12. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

4. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-16 of copending Application No. 09/791,447, or

(b) claims 1-17 of copending Application No. 10/296,037, or

(c) claims 1-15 of copending Application No. 10/311,732, or

(d) claims 1-17 of copending Application No. 10/275,827,

in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596) or BALOG ET AL (US 3,950,301).

The above copending Applications each claim a white, biaxially oriented film comprising at least one layer comprising polyester, white pigment, and the specified type and amount of cycloolefin, as well as other features such as the recited whiteness, opacity, and/or gloss values,

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the use of regrind material; the presence of additional intermediate and/or outer layers, etc.

However, the reference does not explicitly disclose the recited UV stabilizer and flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the white film claimed in the above copending Applications in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have also utilized conventional compounding methods such as masterbatches to incorporate the additives into the polyester composition. It is conventional to incorporate UV stabilizers and flame retardants in the outside layers of a laminate as indicated in claim 11 in order to provide protection for the inner core layers. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties

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comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-13 of U.S. Patent No. 6,627,695 (formerly Application No. 09/781,802); or  
(b) claims 1-15 of U.S. Patent No. 6,635,340 (formerly Application No. 09/781,722),  
in view of in view of UK PATENT APPLICATION GB 2344596 (hereinafter GB '596)  
or BALOG ET AL (US 3,950,301),  
and in view of PEIFFER ET AL (US 5,955,181).

U.S. Patent Nos. 6,627,695 and 6,635,340 each claim a white, biaxially oriented film comprising at least one layer comprising polyester and the specified type and amount of cycloolefin, as well as other features such as the recited whiteness, opacity, gloss values, use of pigment, and the presence of additional intermediate and/or outer layers, etc. However, the reference does not explicitly disclose the use of regrind material and in the case of U.S. Patent No. 6,635,340, the recited UV stabilizer, or in the case of U.S. Patent No. 6,627,695, the recited flame retardant.

GB '596 discloses that it is well known in the art to incorporate a combination of 0.1-10 wt% of known UV stabilizers such as triazines or benzotriazoles and 0.1-45 wt% of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch

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technology (lines 3-4, page 9) in polyester films in order to obtain durable, weather-resistant sheets and laminates. BALOG ET AL discloses that it is well known in the art to incorporate a combination of 0.25-3 wt% of a hydroxybenzotriazole UV stabilizer and 0.5-50 parts by weight of known flame retardants such as organic phosphorus compounds (pages 4-5) by means of masterbatch technology (lines 12-40, col. 7; line 53, col. 7 to line 23, col. 8; line 55, col. 9 to line 42, col. 10) in polyester films in order to obtain durable, weather-resistant sheets and laminates.

PEIFFER ET AL '181 discloses that it is well known in the art to incorporate 20-50 wt% regrind or recycled material into thermoplastic polyester films (lines 30-35, col. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate regrind material into the films claimed in the above patents in order to reduce costs and conserve resources. It also would have been obvious to one of ordinary skill in the art to incorporate both conventional additives such as triazine or hydroxybenzotriazole UV stabilizers and organic phosphorus flame retardants into at least one layer of the claimed white films in order to improve durability, fire resistance, and color stability. One of ordinary skill in the art would have utilized conventional compounding methods such as masterbatches to incorporate the additives into the polyester composition. Since the patent claims polyester compositions containing cycloolefin contents that are substantially comparable to those recited in the claims, the Examiner has reason to believe that the disclosed films would have non-yellowing properties comparable to those recited in the claims, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.



*Response to Arguments*

6. The rejections under 35 USC 103(a) based on SASAKI ET AL has been withdrawn in view of Applicant's arguments filed 10/9/2003 and the showing in the specification.

7. The rejections under 35 USC 103(a) based on JP '319 and JP '349 and JP '717 has been withdrawn in view of Applicant's arguments filed 10/9/2003 and the showing in the specification.

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

December 23, 2003



Vivian Chen  
Primary Examiner  
Art Unit 1773